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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 03/25/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

21F-X5

Office Action Summary

Application No.

09/446,232

Applicant(s)

BIGGS ET AL.

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 21-27 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21-27 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed on 1/21/02 has been entered. Claims 6 and 19 objections have been withdrawn. Claims 3,15,17 rejected under U.S.C 35 USC 112 2nd Paragraph is withdrawn. Applicant has amended claims 3,15,17 removes indefinite language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claims 1,3-15, and 31-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gibson et al (US 3878850). Gibson discloses a smoking material having a non-polyol aerosol generator, up 20% by weight tobacco, binder and inorganic filler (Column 4, Ins. 34-46). As for claims 2-5, the non-polyol aerosol generator being glycerol triacetate, 5% by weight (Column 4, Ins. 34-46). As for claims 6-8, 14 and 33, the inorganic filler, calcium carbonate being present by 45% in weight (Column 4, Ins. 34-46). As for claims 9 and 10, there is no tobacco present in the smoking material, 0% (Column 4, Ins. 34-46). As for claims 11-13, 15 and 34, the binder, carboxymethyl cellulose, being present not more than 20% (Column 4, Ins. 34-46). Gibson clearly anticipates the above claims.

AS for claim 32, a polyol aerosol generator is present at 8.5% (Example 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 2, 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850). As disclosed above Gibson meets all the limitations of claim 1, from which claims 16 and 17 are dependent on. Gibson is silent on using an expansion medium or high oil containing materials. However, Gibson teaches that said smoking material may contain flavourants. It is well known in the art that cocoa, having high fat content, is used as a flavourant. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included flavourants as taught by Gibson such as cocoa, as conventionally used, to enhance the smoking experience.

As for claim 2, the term about 6% leads to variation of 5% to 7%. Hence, about 6% does not patentably distinguish from Gibson's 5% content of non-polyol aerosol generator.

3) Claims 18 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850) in view of Schneider et al (US 5379789 and US 4986287). As disclosed above Gibson meets the limitations of claim 1. Gibson is silent in using said smoking material in a smoking article having a smoking rod and a filter,

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wherein the smoking rod comprises of a core and outer part. However, Schneider et al (US 5379789) discloses a filter and a smoking rod having a core and outer part, wherein said core is a first smoking material (14) enwrapped by a cigarette paper wrapper (16) and wherein the outer part is a second smoking material (18) disposed annularly about said core with a second cigarette paper wrapper (20) enwrapping said second smoking material (18). As for claims 23 and 24, Schneider (US 5379789) discloses the outer part and core extending over the full length of the smoking rod and wherein said core is disposed coaxially of said rod (Figure). Schneider (US 5379789) teaches that said arrangement of the core and outer part results in a considerable reduction of secondary smoke (Column 2, Ins. 35-39). Additionally, Schneider et al (US 4986287) teaches that the core and outer part may be composed of different materials to achieve savings in cost production (Column 1, Ins. 20-25). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used Gibson's smoking material within a smoking article arrangement as disclosed by Schneider because it would reduce secondary smoke and reduce cost production.

4) Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850) in view of Schneider et al (US 5379789 and US 4986287) and in further view of Brown et al (US 5056537). As disclosed above, in paragraph 4, the cited references disclose a smoking article having a smoking material, aerosol generator, binder, inorganic filler and filter. The cited references are silent on a filter having an aerosol generator, as defined in applicant's specification as a polyhydric

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alcohol in the last paragraph of page 3. However, Brown discloses a filter (20) having polyhydric alcohol to impart flexibility to the filter material and avoid heat application when the filter element is being shaped. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included an aerosol generator to the filter element of Schneider because it would impart flexibility to the filter.

Response to Arguments

Applicant's arguments filed 1/21/02 have been fully considered but they are not persuasive. Applicant argues that Gibson does not meet the limitations of claim 1, because it includes a polyol generator. Applicant's claim 1, reciting the term "compromising" provides for the inclusion of other elements, hence polyol generators. Applicant further argues that claim 1 is distinguished over the prior art because it includes a non-polyol generator from about 6% to 30%. However, the argued distinction, a non-polyol generator from about 6% to 30%, over the Gibson patent is not recited in claim 1.

In response to applicant's arguments on claims 21-27, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claims 21-27 explicitly meet the Graham v. Deere test as disclosed below. The '789 patent provides a clear motivation to one of ordinary skill in the art to arrange the smoking material of the '850 patent in coaxial arrangement as taught by the '789 in

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order to reduce side stream smoke. Furthermore, the '537 provides a clear motivation to one of ordinary skill in the art to provide aerosol generators at the filter section in order to provide flexibility to a filter.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon. - Fri. 8am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (703) 308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L
March 19, 2002


JOSE FORTUNA
PATENT EXAMINER